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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,407	07/24/2003	Samih Tarabichi	8696-1	1058

21184 7590 12/04/2007  
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EXAMINER
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HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
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3736

MAIL DATE	DELIVERY MODE
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12/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/626,407	Applicant(s) TARABICHI, SAMIH	
	Examiner Jeffrey G. Hoekstra	Art Unit 3736	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/28/2007 has been entered.

### ***Notice of Amendment***

2. In response to the amendment filed on 09/28/2007, amended claim(s) 1 is/are acknowledged. The current rejections of the claim(s) 1, 2, 5, and 7-11 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

### ***Claim Objections***

3. Claims 2 and 9 are objected to because of the following informalities: the positive recitation of "the distance" in line 2 should apparently read "a distance". Appropriate correction is required.

4. Claims 5 and 10 are objected to because of the following informalities: the positive recitation of "the angulation" in line 2 should apparently read "an angulation". Appropriate correction is required.

5. Claim 8 is objected to because of the following informalities: the positive recitation of "and lower section" in lines 3-4 should apparently read "and a lower section". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Waldock et al (US 5,484,447, hereinafter Waldock).

8. For claim 1, Waldock shows and discloses a dynamic spacer capable of measuring the flexion and extension gaps during knee arthroplasty, comprising:

- a first planar member (12) having a lower tissue engaging surface (46a) and an upper tensioning surface (the surface opposing 46a) (as best seen in Figure 9);
- a second planar member (10) having an upper tissue engaging surface (46b) and a lower tensioning surface (the surface opposing 46b) (as best seen in Figure 9); and
- a tension means (20 or 54) residing entirely between said first and said second planar members for applying a tensile force acting upon said first and second planar members on said lower and upper tensioning surfaces (as best seen in Figure 9);
- said tensioning means fixedly attached to said upper and lower tensioning surfaces of said first and second planar members (as best seen in Figures 1, 5, 7, and 9).

9. For claim 2, Waldock shows and discloses a dynamic spacer for measuring the flexion and extension gaps during knee arthroplasty, further comprising: a means for measuring a distance ((16 and 18) or (16, 40 and 44)) between the lower and upper tissue engaging surfaces of said first and second planar members (as best seen in Figures 1, 5, 7, and 9).

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waldock in view of Muhs et al (US 5,701,370, hereinafter Muhs). Waldock teaches the claimed invention except for expressly teaching a means for measuring an angulation between said first and second planar members as the second planar member deviates from parallel with respect to the first planar member. Muhs teaches a means for measuring an angulation between said first and second planar members as the second planar member deviates from parallel with respect to the first planar member (column 3 lines 33-45) (as best seen in Figure 1). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. All of the component parts are known in Waldock and Muhs. The only difference is the combination of the component parts into a single device. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the components as taught by Waldock with the components as taught by Muhs to achieve the predictable results of measuring anatomical dimensions.

12. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waldock in view of Ishizuka (US 6,716,043, hereinafter Ishizuka). Waldock teaches the claimed invention except for expressly teaching a tensioning means comprising a

plurality of compressive coil springs wherein said springs are encapsulated in a plurality of segmented cylindrical spring housings wherein upper and lower segmented portions have different diameters and are slidably engaged. Ishizuka teaches the use of a plurality of compressive coil springs (12) for tensioning mean. Moreover, Ishizuka teaches a plurality of segmented cylindrical spring housings encapsulating said plurality of compressive coil springs wherein said segments are of differing diameters in order to be slidably engaged (as best seen in Figures 2 and 4). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. All of the component parts are known in Waldock and Ishizuka. The only difference is the combination of the component parts into a single device. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the components as taught by Waldock with the components as taught by Ishizuka to achieve the predictable results of providing a tensioning means.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waldock in view of Ishizuka as applied to claims 7 and 8 above, and further in view of Weisman et al (US 3,722,100, hereinafter Weisman). Waldock in view of Ishizuka teaches the claimed invention except for expressly teaching segmented cylindrical housing having graduated indices for measuring distance. Weisman teaches a segmented cylindrical housing with graduated indices (16, 36) for measuring distance (as best seen in Figure

2). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. All of the component parts are known in Waldock in view of Ishizuka and Weisman. The only difference is the combination of the component parts into a single device. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the components as taught by Waldock in view of Ishizuka with the components as taught by Weisman to achieve the predictable results of measuring anatomical dimensions.

14. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waldock in view of Ishizuka in view of Weisman as applied to claim 9 above, and further in view of Muhs. Waldock in view of Ishizuka in further view of Weisman teaches the claimed invention except for expressly teaching measuring angulation and additionally comprising a fixedly attached positioner (column 3 lines 33-45) (as best seen in Figure 1). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. All of the component parts are known in Waldock in view of Ishizuka in view of Weisman and Muhs. The only difference is the combination of the component parts into a single device. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the components as taught by Waldock in view of

Ishizuka in view of Weisman with the components as taught by Muhs to achieve the predictable results of measuring anatomical dimensions.

***Response to Arguments***

15. Applicant's arguments with respect to claims 1, 2, 5, and 7-11 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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/J.H./  
Jeff Hoekstra  
Examiner, Art Unit 3736

A handwritten signature in black ink, appearing to read "M. H. Hoekstra", written in a cursive style.